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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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No.

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on December 29, 1965 (R. 227).

I. CITATIONS TO OPINIONS BELOW

The opinion of the District Court (R. 216), printed in Appendix A of this petition, is not yet reported in the Federal Reporter System. The opinion of the

Court of Appeals as entered December 29, 1965[1] and as amended *sua sponte* by Order of the Court dated February 28, 1966 (R. 266) appears at R. 267. The opinion, as amended, is printed in Appendix B of this petition. Neither opinion of the Court of Appeals has been reported as yet in the Federal Reporter System.

II. JURISDICTION

The judgment of the Court of Appeals for the District of Columbia Circuit was entered on December 29, 1965 (R. 227). The jurisdiction of this Court is invoked under Title 28, United States Code, Section 1254(1).

III. QUESTION PRESENTED

Is it denial of due process for the Commissioner of Patents to issue a trademark registration without complying with the provisions of the trademark statutes and his own rules of practice?

IV. STATUTES INVOLVED

The statutes involved, printed in Appendix C1 of this petition, are as follows:

Sections 1, 12(a), 12(b), 13 and 41 of the Trademark Act of 1946 (Title 15, United States Code, Sections 1051, 1062(a), 1062(b), 1063 and 1123, respectively).

Section 10, Administrative Procedure Act.

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[1] The opinion of the Court of Appeals filed December 29, 1965 was amended by the Court, *sua sponte*, on February 28, 1966 after denial of a Petition for Rehearing En Banc on February 8, 1966 (R. 265).

V. TRADEMARK RULES OF PRACTICE INVOLVED

The Trademark Rules of Practice involved, printed in Appendix C2 of this petition, are as follows:

Trademark Rules 2.21(c), 2.22, 2.33(a)(iv), 2.33(a)(v), 2.33(b), 2.51(a), (b) and (d), 2.56, 2.61(a), 2.61(b), 2.63, 2.71(a), (b) and (c), 2.81, 2.84(a) and (b), 2.101, 2.104, 2.107, 2.146(a)(3), 2.147, 2.148.

VI. STATEMENT

WEATHER-RITE SPORTSWEAR CO., INC. filed trademark application Serial Number 172,441 in the United States Patent Office on July 3, 1963 seeking registration of "GOODYEAR BY WEATHER-RITE" for "RAINWEAR, NAMELY, COATS, BOOTS, HATS AND WATERPROOF SPORTING GOODS APPAREL" (R. 87-91, inclusive).[2]

The application was referred to an Examiner for action pursuant to Trademark Rules 2.61(a) and (b). Registration was refused by the Examiner on the ground, among others, that the description of applicant's goods did not comply with the requirements of Section 1(a)(1) of the Trademark Act and Trademark Rule 2.33(v) because the wording of the description was "broad and indefinite" (R. 92). Registration was also refused because the drawing did not comply with the requirements of Section 1(a)(2) of the Trademark Act and Trademark Rules 2.33(a) (iv) and 2.51(a), (b) and (d) (ibid).

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[2] Weather-Rite is in no way connected with The Goodyear Tire & Rubber Company. The goods, imported from Japan by Weather-Rite (R. 23-44), are not made by The Goodyear Tire & Rubber Company nor are they made of materials manufactured or supplied by Goodyear.

The applicant amended the description of goods (R. 98) and filed a substitute drawing (R. 117) to overcome the Examiner's rejection. As amended, the goods were described as "RAINWEAR, NAMELY, RAINCOATS, RAINSUITS, RAINHATS, PONCHOS, AND WATERPROOF FISHING SHIRTS, HUNTING SHIRTS, VESTS AND JACKETS, BOOTS, SHOES AND OVERSHOES AND GROUND CLOTHS" (R. 98). The mark shown in the new drawing was "GOODYEAR DE LUXE BY WEATHERRITE" (R. 117). The only specimens on file in the case at that time, however, showed use of the mark only on "baseball shoes" (R. 90).

The Commissioner of Patents caused the mark to be published in the Official Gazette of the Patent Office on May 12, 1964 (R. 8) to enable anyone who felt he might be damaged by the registration of the mark to oppose issuance of a registration thereof, as provided by Section 13 of the Trademark Act and Trademark Rules 2.101 and 2.104. After the 30 day period for opposition had passed, without the filing of an opposition by anybody, but as a consequence of a series of petitions filed by The Goodyear Tire & Rubber Company (petitioner here) [R. 9, 12 and 17], the Commissioner ultimately withdrew the allowance of the application[3] (R. 221) and on October 12, 1964 remanded it to the Examiner for re-examination (R. 146).

The Examiner re-examined the application as provided in Trademark Rule 2.63 and rejected it on Octo-

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[3] If the allowance had not been withdrawn, the mark would have been registered on October 13, 1964 as Registration 778,540. In view of the withdrawal, no registration was issued.

ber 15, 1964 (R. 222), holding that the specimens of the mark which were on file in the application did not show the mark "GOODYEAR DE LUXE BY WEATHERITE" on the goods as described in the application at the time the mark was published in the Official Gazette on May 12, 1964. The only specimens on file at that time showed use of the mark for baseball shoes, whereas baseball shoes were not included in the amended description of goods as of May 12, 1964.

The applicant responded on October 22, 1964 (R. 149-155) by submitting new evidence in the form of additional specimens showing use of the mark on "cold weather boots" (R. 153-155), accompanied by an affidavit of an officer of the company[4] (R. 152) asserting retroactively that the mark shown on the new specimens was in use on the date the application was originally filed, namely, July 3, 1963. *Obviously, this new evidence was not of record when the mark was published on May 12, 1964.* No specimens, whatever, have ever been submitted to show that the mark was used, if ever, on the rest of the goods named in the amended description, namely, "RAINCOATS, RAINSUITS, RAINHATS, PONCHOS, AND WATERPROOF FISHING SHIRTS, HUNTING SHIRTS, VESTS AND JACKETS, SPORT JACKETS, ****, SHOES AND OVERSHOES, AND GROUND CLOTHS".

Petitioner, The Goodyear Tire & Rubber Company, learned from the Patent Office file that the Commissioner was about to issue a registration of "GOOD-

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[4] When the description of goods is amended, Trademark Rule 2.71 requires the filing of additional specimens and a supplemental affidavit by the applicant, just as if it were a newly filed case (Appendix C2, page 16a, *infra*).

YEAR DE LUXE BY WEATHERITE" to the applicant without publishing the mark in the Official Gazette to afford an opportunity for Goodyear or any other person to oppose the issuance of a registration on the basis of the application as it stood after the aforementioned addition of new evidence (R. 78-79). This action was taken by the Commissioner notwithstanding the fact that a request filed by Goodyear on October 9, 1964 (R. 17-69) for reconsideration of the Commissioner's action of October 6, 1964 (R. 15) was pending, but "appears to have been mislaid in the Patent Office" (R. 81).

Since the issuance of a registration was imminent unless prompt action was taken to preserve its rights, petitioner, Goodyear, filed a civil action in the United States District Court for the District of Columbia against the Commissioner of Patents under Section 10 of the Administrative Procedure Act (R. 2-70). A temporary restraining order was issued at 4:00 P.M. on November 23, 1964 directing the Commissioner to withhold registration and maintain the status quo pending the outcome of the civil action[5] (R. 74-75).

The complaint was amended (R. 75), pleading the facts relating to the withdrawal of the application from issue, the re-examination thereof and the threat of the Commissioner to issue the registration without

[5] The temporary restraining order was continued in force by consent of the parties and is still in force pending final disposition of this action. Had this action not been taken, the Commissioner would have issued Registration 780,649 to Weather-Rite at noon on November 24, 1964 (R. 147). In view of the fact that the temporary restraining order is still in force, no registration has issued. Once a registration is issued, petitioner and the public loses forever its right to oppose issuance of the registration under Section 13 of the Trademark Act.

publishing the mark for opposition after the application had been re-examined in the light of the amendment presented in an effort to overcome the fatal deficiency of the applicant. Prayer B sought to compel the Commissioner to publish the mark in accordance with Section 12(a) of the Trademark Act and Trademark Rule 2.81.

Cross-motions for summary judgment (R. 161) and to dismiss (R. 76) were filed by Goodyear and the Commissioner, respectively, there being no dispute as to any genuine issue of material fact and the matter being ripe for consideration *as a matter of law.*

The complaint was dismissed by the District Court after a hearing on the motions (R. 219). A memorandum opinion was filed (R. 216, Appendix A, page 1a, infra).

Appeal was taken to the United States Court of Appeals for the District of Columbia Circuit by Goodyear (R. 219) and the injunction was continued in force pending the appeal (R. 220).

The judgment of the District Court dismissing the complaint was affirmed by the Court of Appeals on December 29, 1965 (R. 227). The opinion filed on the same date was amended, *sua sponte,* by the Court on February 28, 1966 (R. 266, Appendix B, page 4a, infra) even though the Court, *en banc,* denied petitioner's petition for rehearing *en banc* on February 8, 1966 (R. 265).

The present petition is filed, seeking review by writ of certiorari to the Court of Appeals for the District of Columbia Circuit.

VII. REASONS FOR GRANTING THE WRIT

The Commissioner of Patents is charged by Congress with the responsibility for registration of trademarks (35 USC 6). As a part of that responsibility he has a duty to the public to afford it an opportunity to oppose registration of trademarks which do not meet the requirements of the statutes and trademark rules (15 USC 1063). Before affording the public an opportunity to oppose, the Commissioner is charged with the responsibility of examining the application for compliance with the statutes and rules [15 USC 1062(a)]. If, upon "examination or re-examination" it appears that the applicant is entitled to registration, "he shall cause the mark to be published in the Official Gazette of the Patent Office" (Trademark Rule 2.81), whereby the public is afforded an opportunity to oppose the issuance of the registration sought, as provided in 15 USC 1063.

Where, as here, the Commissioner publishes a mark before the requirements of the statutes and rules have been met, and then refuses to publish it again for opposition after those requirements have been met, there is a denial of due process since he is denying the public the right to oppose the issuance of a registration on the facts as they stand in the application after such amendment, i.e., at the time and under the circumstances which would otherwise lead to the issuance of a registration.

The question is one of great public importance which should be decided by this Court since it relates to the administrative process as conducted by all agencies of the Executive Branch and not just to an abuse of the administrative process by the Commissioner of Pat-

ents, whose decisions are accorded a virtually conclusive presumption of correctness[6] by the Courts of the District of Columbia Circuit, but whose decisions are not accorded the same presumption by the Court of Customs and Patent Appeals. The Solicitor for the Patent Office sought to exploit this dichotomy in his argument before the Court in the present case (R 196).

It is significant to note that the refusal of the Commissioner to publish the mark after the amendment was entered is totally inconsistent with the action he took in every case where the issue of second publication was raised heretofore. The Solicitor for the Patent Office admitted that such was the case (R. 191). Illustrations of those cases are set forth in Petitioner's "Petition for Rehearing En Banc" (R 241-242, 246-251).

The present petition should be granted, if for no other reason, at least to resolve once and for all the question of whether the Commissioner of Patents is to be the sole arbiter of the statutes and his own rules or if the Courts are to be the guardians of the public interest by assuring fair, strict, and proper adherence to the administrative process by the Commissioner, as well as the public. The public (for whose benefit the patent and trademark laws are intended) finds itself

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[6] See the recent decisions of the Court of Appeals for the District of Columbia Circuit in *Hays et al.* v. *Brenner*, 148 USPQ 365, footnote 6, 366; *Reynolds* v. *Aghnides*, 148 USPQ 245, 246. It will be noted that there is a direct conflict between those decisions and the following decisions of the Court of Customs and Patent Appeals:

In re Pappas et al., 185 F. 2d 695 (CCPA, 1950)
In re Hummer, 241 F. 2d 742 (CCPA, 1957)
In re Citron, 251 F. 2d 619 (CCPA, 1958)

bogged down in a hopeless morass of legalisitc "buck-passing" as a consequence of the conflict which exists between the Courts of appellate jurisdiction, and should be disentangled by appropriate action of the Supreme Court.

Counsel for petitioner has not found any case decided by this Court on the point involved herein, namely whether the Commissioner may disregard his own rules of practice, as well as the clear and unequivocal terms of the statutes, under the guise of the exercise of administrative discretion. Unless the Judicial Branch insists upon strict adherence by administrative officials to the rules of practice adopted by the Executive Branch and the statutes enacted by the Legislative Branch, the ever-diminishing line of demarcation between the three Branches will become non-existent, the Executive Branch will be a law unto itself, and the Administrative Procedure Act will be a nullity.

The Court of Appeals for the District of Columbia Circuit has made it clear that it does not want to be bothered with cases arising under the Administrative Procedure Act (See *Wembley, Inc.* v. *Commissioner of Patents,* F. 2d ; 147 USPQ 86, where the Court said: "The Administrative Procedure Act, upon which Wembley relies, provides that preliminary, procedural or intermediate agency action or ruling, not directly reviewable, shall be subject to review upon review of the final agency action. * * * * For the Court to move in by mandamus or like remedy to police such rulings of an agency in the course of its proceedings would be

quite contrary to the established norms of judicial review of agency action".)[7]

It is evident that the Courts of the District of Columbia Circuit are surrendering their judicial prerogatives to the Executive Branch and, at the same time, widening the breach between them and the Court of Customs and Patent Appeals. The result is that the public is left to the mercy of that enigmatic (and often fickle) phenomenon normally referred to as "administrative discretion" encountered in the functioning of the administrative machinery of the Executive Branch. Only review by the Supreme Court of the United States and the establishment of a policy of *judicial* enforcement of the administrative process will confine such "discretion" within proper bounds and preclude its use to violate or ignore the express terms of the statutes and rules of practice by the Commissioner of Patents and other administrative bodies and officials. At the same time, it will resolve the diametrically opposed positions of the Courts of the District of Columbia Circuit and the Court of Customs and Patent Appeals, which positions are presently irreconcilable.

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[7] The District Court (235 F. Supp. 704) vacillated in that case, having originally held for plaintiff, but on motion for reconsideration brought by the government, reversed itself and dismissed the complaint, holding that the application of the Patent Office rules was discretionary, citing *Anderson* v. *Watson*, 103 App. D. C., 254 F. 2d 956. In the present case it will be noted that the Court of Appeals also gave the government favored treatment in allowing it to file a brief after the case had been submitted; ignored appellant's indication of a desire to file a reply; denied appellant's petition for rehearing *en banc;* and *then, sua sponte,* amended its opinion without vacating the judgment entered on the opinion previously rendered.

VIII. CONCLUSION

The question for review is presented in the simplest terms possible. Petitioner submits that it, and the public at large, are left without a remedy if the Courts permit administrative officials to circumvent the statutes and their own rules of practice under the guise of exercise of "administrative discretion". This is not the first time it has happened. It will happen again and again unless and until the Supreme Court of the United States makes it clear that there should not be one interpretation of the laws and rules on behalf of the government and another interpretation on behalf of the public. The double standard in the application of "administrative discretion", if discretion rests in the administrative official, should be abolished once and for all.

This is a case in which the Supreme Court of the United States can roll back (or at least restrain) the tide of bureaucracy before it completely engulfs the judiciary as well as the public.

Petitioner respectfully prays, for all of the foregoing reasons, that the present petition be granted.

Respectfully,

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APPENDIX A

Filed Feb. 23, 1965

Memorandum Opinion

This is a civil action brought under Title 5, Section 1009 of the Federal Administrative Procedure Act. Plaintiff, Goodyear Tire & Rubber Company, seeks to have the Court enjoin the defendant, Commissioner of Patents, from granting a trademark registration on an application Serial No. 172,441, filed by Weather-Rite Sportswear Co., Inc., for the mark "GOODYEAR DELUXE BY WEATHERITE".

Weather-Rite's application was at first refused by the Patent Office, but then amended, re-examined, passed to issue, and finally published in the Official Gazette on May 12, 1964. Section 12(a) of the Trademark Act of 1946 requires such publication where a mark is found registrable, and Section 13 of the Act creates a right in interested parties to institute proceedings in the Patent Office in opposition to registration of published marks. Plaintiff here neglected through inadvertence to institute such proceedings within the time allotted. The Patent Office, on its own motion, however, later withdrew the mark from issue, refused it registration, and upon re-examination found once again that it was entitled to be registered. The reason for the second re-examination was belated recognition by the Patent Office that the amended statement of goods to be covered was not supported by the Specimens originally filed. Upon submission of new specimens, the mark was again passed to issue, but without republication.

The plaintiff in its amended complaint prays that the Patent Office be directed to publish the mark for an additional period as a consequence of the re-examination. In the alternative, plaintiff asks the Court to direct the Patent Office to withhold registration of the mark pending resolution of another opposition proceeding (No. 44,248, involving "GOODYEAR DELUXE BY IRCO") in the Patent Office

involving similar issues, and pending the outcome of litigation in other federal district courts, also involving similar issues. Plaintiff is a party to both the opposition proceedings in the Patent Office and to the litigation in the other federal courts.

On the day before the registration would have been effected by the Patent Office, this Court granted temporary relief restraining the registration pending a hearing on plaintiff's allegations. Defendant has moved to dissolve the restraining order and to dismiss the Complaint. The plaintiff has moved for summary judgment.

Treating the question of republication first, it seems that this is governed by Rule 2.81 of the Trademark Rules of Practice. The Rule reads in part:

> "If, on examination or re-examination of an application for registration of the Principal Register it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition."

The meaning of the term "re-examination" as used in Rule 2.81 is indicated by Rule 2.63, as follows:

> "2.63. Re-Examination. After response by the applicant, the application will be re-examined or reconsidered, ..."

The plaintiff contends that failure to republish the mark for an additional period deprives it of the right to file opposition proceedings against it, and hence denys plaintiff due process of law. The defendant asserts that one publication is enough to satisfy the rule so long as the mark is not amended upon re-examination in such a way as to invite opposition to the mark in its amended form that would not have been invited by its form when originally published. *Carter Medicine Co.* v. *Barclay*, 36 U.S. App. D.C. 123 (1910).

The Court believes the defendant's view of the matter is the sounder. It cannot seriously be argued that inadequacy of specimens would have any significant effect on the decision to oppose the mark by one reading the Official Gazette. If this trademark were republished it would be in the same form as before. The sole effect of republication would be to subject the owner of the mark to a period of exposure twice as great as that normally required, and to do so solely because the Patent Office neglected to make an accurate judgment regarding the specimens at the proper time for so doing.

The plaintiff still has open to it the remedy of having the trademark cancelled by the Patent Office after it is registered. Plaintiff's burden of proof is no greater in cancellation proceedings than it is in opposition proceedings, so it cannot claim injury in that connection. The Court agrees with defendant that the essential purpose of publication has been accomplished, and agrees also that the purpose of the time limitation for filing oppositions would be frustrated by sanctioning exceptions to it on grounds as tenuous as herein set forth.

Plaintiff's alternative prayers for relief have no legal basis of which the Court is aware. The fact that plaintiff is party to one opposition proceeding in the Patent Office does not make it a party to another. It does not have standing to frustrate issuance of a registration it neglected to oppose, even though it did not neglect to oppose one similar to it. Correspondingly, plaintiff's participation in lawsuits throughout the nation cannot confer upon it status before the Patent Office plaintiff has lost through failure to comply with Patent Office rules.

The Court will dissolve the restraining order and dismiss the Complaint.

DATED: February 23, 1965.

JOSEPH R. JACKSON
United States District Judge

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19276

THE GOODYEAR TIRE & RUBBER COMPANY, APPELLANT,

v.

THE COMMISSIONER OF PATENTS, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided December 29, 1965

As amended February 28, 1966

Mr. Francis C. Browne for appellant. *Mr. Richard G. Kline* also entered an appearance for appellant.

Mr. George C. Roeming, Attorney, United States Patent Office, for appellee. *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief for appellee.

Before: PRETTYMAN, *Senior Circuit Judge,* BURGER and LEVENTHAL, *Circuit Judges.*

PER CURIAM: Weather-Rite Sportswear Company made application for the mark "GOODYEAR DELUXE BY WEATHER-

RITE." In accordance with § 12 of the Trademark Act, 15 U.S.C. § 1062, the mark was duly referred to an examiner, and it appearing on examination that the application was entitled to registration, the mark was published for opposition on May 12, 1964.

Appellant failed to file its opposition within the thirty day period provided in § 13 of the Trademark Act, 15 U.S.C. § 1063. Pursuant to a suggestion from appellant the Patent Office subsequently withdrew the Weather-Rite mark from issue and ordered re-examination of the application. The problem was that the originally submitted specimens had not supported the description in the application of the goods to be covered by the mark. Applicant promptly submitted corrected specimens, the Examiner found the mark entitled to registration, and it was passed to issue, to be matured into a registration, without republication.

Appellant seeks in this action to require the Commissioner of Patents to republish the trademark for purposes of opposition. The District Court correctly held, 238 F. Supp. 509, 511, that a second publication is not required unless the mark has been amended "in such a way as to invite opposition to the mark in its amended form that would not have been invited by its form when originally published."

We also agree that the correction of Weather-Rite's specimens was not such a substantial amendment of the application as to require a second publication. *Carter Medicine Co.* v. *Barclay,* 36 App. D.C. 123 (1910), is not to the contrary. The court held the Commissioner was justified in republishing the mark where there had been an

amendment of substance to the trademark application.[1] Appellant's ground for opposition to the mark existed at the time of the publication on May 12, 1964, and is not attributable to applicant's correction of specimens. The Patent Office was justified in issuance on reexamination without a second publication and remitting appellant to its remedy, under § 14 of the Act (15 U.S.C. § 1064), for cancellation of the registration.

Affirmed.

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[1] In *Carter* the court stated (see 36 App. D.C. at 127) that the Commissioner was exercising the discretion given him by the provision of the Trademark Act that "the commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office." Act of Feb. 20, 1905, c. 592 § 6, 33 Stat. 726.

The 1905 Act was replaced by the Act of July 5, 1946, c. 540, § 12, 60 Stat. 432. Although the words "at least once" were omitted in the 1946 revision, we do not read this change as a prohibition of a second publication, or as a limitation on the Commissoner's discretion under the *Carter* case.

In *Carter* the court pointed out differences between the original application, for registration of a technical trademark, and the amended application, for registration of a non-technical mark, in terms of the necessary showing and available defenses and said (36 App. D.C. at 126): "It was quite possible for an opposition to lie against the amended application, and not against the original."

APPENDIX C-1

Administrative Procedure Act

JUDICIAL REVIEW

Sec. 10. Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion—

(a) RIGHT OF REVIEW.—Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

(b) FORM AND VENUE OF ACTION.—The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence of inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

(c) REVIEWABLE ACTS.—Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial review. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the

action meanwhile shall be inoperative) for an appeal to superior agency authority.

(d) INTERIM RELIEF.—Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court), is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

(e) SCOPE OF REVIEW.—So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold unlawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 7 and 8 or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error.

• • • • • • • • • • •

Trademark Act of 1946, as Amended

Public Law 489, 79th Congress, Chapter 540,
approved July 5, 1946; 60 Stat. 427

* * * * * * * * * *

Section 1 (15 U.S.C. 1051). Requirements for registering trademarks on the principal register

The owner of a trademark used in commerce may register his trademark under this Act on the principal register hereby established:

(a) By filing in the Patent Office—

(1) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive: Provided, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods in connection with which and the areas in which each concurrent use exists,

the periods of each use, and the goods and area for which the applicant desires registration;

(2) a drawing of the mark; and

(3) such number of specimens or facsimiles of the mark as actually used as may be required by the Commissioner.

(b) By paying in the Patent Office the filing fee.

(c) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(d) If the applicant is not domiciled in the United States he shall designate by a written document filed in the Patent Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with him or mailing to him a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

• • • • • • • • • • •

Section 12(a) (15 U.S.C. 1062a). Examination of application—*Publication of mark when entitled to registration*

Upon the filing of an application for registration and payment of the fee herein provided, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent Office: *Provided,* That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section

16 of this Act, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

Section 12(b) (15 U.S.C. 1062b). Examination of application—Refusal of registration when not entitled....

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of 6 months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of 6 months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended.

• • • • • • • • • • •

Section 13 (15 U.S.C. 1063). Opposition to registration of marks on the principal register

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file a verified opposition in the Patent Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. For good cause shown, the time for filing opposition may be extended by the Commissioner, who shall notify the applicant. An unverified opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing to be fixed by the Commissioner. An opposition may be amended under such conditions as may

be prescribed by the Commissioner (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

• • • • • • • • • • •

Section 41 (15 U.S.C. 1123). Commissioner to make rules for proceedings in the Patent Office

The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office under this Act.

APPENDIX C-2

Application for Registration

2.21 *Parts of application.* A complete application for registration comprises:

(a) A written application (see rules 2.31 to 2.47);

(b) A drawing of the mark (see rules 2.51 to 2.55);

(c) Five specimens or facsimiles (see rules 2.56 to 2.58);

(d) The required filing fee;

(e) A certification or a certified copy of the registration in the country of origin if the application is based on such foreign registration pursuant to section 44(e) of the act (see rule 2.39).

AUTHORITY NOTE: Rules 2.21 to 2.47 interpret or apply sec. I, 60 Stat. 427; 15 U.S.C. 1051.

2.22 *Application must be complete to receive filing date.* An application will not be considered filed unless all the required parts specified in rule 2.21, complying with the rules relating thereto, are received, but minor informalities may be waived subject to subsequent correction. If the papers are incomplete or so defective that they cannot be accepted, the applicant will be notified and the papers and fee held six months for completion. If the application is not completed within such time, the papers and fee will be returned to the applicant or otherwise disposed of; the

drawing or fee of an unaccepted application may be transferred to a later application.

* * * * * * * * * *

2.33 *Requirements for application.* (a) (1) The application shall include a request for registration and shall specify:

(i) The name of the applicant;

(ii) The citizenship of the applicant; if the applicant be a partnership, the names and citizenship of the general partners or, if the applicant be a corporation or association, the state or nation under the laws of which organized;

(iii) The domicile and post office address of the applicant;

(iv) That the applicant has adopted and is using the mark shown in the accompanying drawing;

(v) The particular goods on or in connection with which the mark is used;

(vi) The class of merchandise according to the official classification, if known to the applicant;

(vii) The date of applicant's first use of the mark as a trademark on or in connection with goods specified in the application (see rule 2.38);

(viii) The date of applicant's first use in commerce of the mark as a trademark on or in connection with goods specified in the application, specifying the nature of such commerce (see rule 2.38);

(ix) The mode, manner or method of applying, affixing or otherwise useing the mark on or in connection with the goods specified.

(2) If more than one item of goods is specified in the application, the dates of use required in subparagraph (1) (vii) and (viii) of this paragraph need be for only one

of the items specified, provided the particular item to which the dates apply is designated.

(3) The word "commerce" as used throughout this part means commerce which may lawfully be regulated by Congress, as specified in section 45 of the act.

(b) The application must also include averments to the effect that the applicant or other person making the verification believes himself or the firm, corporation, or association in whose behalf he makes the verification to be the owner of the mark sought to be registered; that the mark is in use in commerce, specifying the nature of such commerce; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that the specimens or facsimiles show the mark as actually used in connection with the goods; and that the facts set forth in the application are true.

(c) For an application for the registration of a mark for goods or services falling within a plurality of classes, see rule 2.87.

* * * * * * * * * *

Drawing

AUTHORITY NOTE: Rules 2.51 to 2.55 interpret or apply sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

2.51 *Drawing required.* (a) The drawing of the trademark shall be a substantially exact representation thereof as actually used on or in connection with the goods.

(b) The drawing of a service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services. The drawing of a service mark may be dispensed with in the case of a mark not

capable of representation by a drawing, but in any such case the application must contain an adequate description.

* * * * * * * * * *

(d) If the application is for the registration only of a word, letter or numeral, or any combination thereof, not depicted in special form, the drawing may be the mark typed in capital letters on paper, otherwise complying with the requirements of rule 2.52.

* * * * * * * * * *

Specimens

AUTHORITY NOTE: Rules 2.56 to 2.58 interpret or apply sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

2.56 *Specimens.* The five specimens of a trademark shall be specimens of the trademark as actually used on or in connection with the goods in commerce, and shall be duplicates of the actually used labels, tags, or containers, or the displays associated therewith or portions thereof, when made of suitable material and capable of being arranged flat and of a size not larger than the size of the drawing.

* * * * * * * * * *

Examination of Application and Action by Applicants

AUTHORITY NOTE: Rules 2.61 to 2.69 interpret or apply sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

2.61 *Action by Examiner.* (a) Applications for registration will be examined or caused to be examined by the Examiner of Trademarks, and, if the applicant is found not entitled to registration for any reason, he will be so notified and advised of the reasons therefor and of any formal requirements or objections.

(b) The Examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

* * * * * * * * * *

2.63 *Re-examinations.* After response by the applicant, the application will be re-examined or reconsidered, and if the registration is again refused or formal requirements insisted upon, but not stated to be final, the applicant may respond again.

* * * * * * * * * *

Amendment of Application

AUTHORITY NOTE: Rules 2.71 to 2.75 interpret or apply sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

2.71 *Amendments to application.* (a) The application may be amended to correct informalities, or to avoid objections made by the Patent Office, or for other reasons arising in the course of examination. No amendments to the dates of use will be permitted unless such changes are supported by affidavit by the applicant and by such showing as may be required by the Examiner.

(b) Addition to the specification of goods or services will not be permitted unless the mark was in actual use on all of the goods or services proposed to be added by the amendment at the time the application was filed and unless the amendment is accompanied by additional specimens (or facsimiles) and by a supplemental affidavit by the applicant in support thereof.

(c) Amendment of the verification will not be permitted. If that filed with the application be faulty or defective, a substitute or supplemental verification must be filed.

* * * * * * * * * *

Publication and Allowance

2.81 *Publication in Official Gazette.* If, on examination or re-examination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition. The

mark also may be so published in the case of an application to be placed in interference or concurrent use proceeding, if otherwise registrable.

* * * * * * * * * *

2.84 *Jurisdiction over published or allowed applications.* (a) After ~~publication or~~ allowance the Examiner may exercise jurisdiction over an application by special authority from the Commissioner.

(b) Amendments may be made after the allowance of an application if the certificate has not been printed, on the recommendation of the Examiner approved by the Commissioner, without withdrawing the allowance.

* * * * * * * * * *

Opposition

AUTHORITY NOTE: Rules 2.101 to 2.106 interpret or apply secs. 13, 17, 60 Stat. 433, 434; 15 U.S.C. 1063, 1067.

2.101 *Time for filing opposition.* Any person who believes that he would be damaged by the registration of a mark upon the Principal Register may, upon payment of the required fee, oppose the same by filing a verified opposition in the Patent Office within thirty days after the publication (rule 2.81) of the mark sought to be registered.

* * * * * * * * * *

2.104 *Contents of opposition.* The opposition must allege facts tending to show why the opposer would be damaged by the registration of the opposed mark and state the specific grounds for opposition. A duplicate copy of the opposition including exhibits shall be filed.

* * * * * * * * * *

2.107 *Amendment of opposition.* An opposition may be amended in the same manner and to the same extent as a complaint in a civil action before a United States district court. See Rule 15 of the Federal Rules of Civil Procedure.

Petitions and Action by the Commissioner

2.146 *Petition to the Commissioner.* (a) Petition may be taken to the Commissioner (1) from any repeated action or requirement of the Examiner of Trademarks, not subject to appeal under rule 2.141, in the ex parte prosecution of an application; (2) in cases in which the statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Any brief in support thereof should accompany or be embodied in the petition; in contested cases any brief in opposition shall be filed within fifteen days after service of the petition. Where facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits (and exhibits, if any) must accompany the petition.

(c) An oral hearing will not be held except when considered necessary by the Commissioner.

(d) The mere filing of a petition will not stay the period for replying to an Examiner's action, nor stay other proceedings.

(e) Authority to act on a petition may, when appropriate, be delegated by the Commissioner.

(f) No fee is required for a petition to the Commissioner.

2.147 *Cases not specifically defined.* All cases not specifically defined and provided for by the rules in this part will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

2.148 *Commissioner may suspend certain rules.* In an extraordinary situation, when justice requires and no other party is injured thereby, any requirement of the rules in this part not being a requirement of the statute may be suspended or waived by the Commissioner.

* * * * * * * * * *

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, PETITIONER

v.

THE COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

The Weather-Rite Sportswear Company made application to the Patent Office for the registration of the trade-mark, "Goodyear Deluxe By Weatherite".[1] After some correspondence and amendments by Weather-Rite to its application,[2] the patent examiner,

[1] In 1888 this Court, in *Goodyear's India Rubber Glove Manufacturing Co.* v. *Goodyear Co.*, 128 U.S. 598, held that "Goodyear Rubber" was merely descriptive of the rubber produced by Goodyear's process, *i.e.*, vulcanized rubber, and was not subject to exclusive appropriation. In the years since that decision, the term "Goodyear" has been used in the trade-marks of numerous companies other than petitioner. *E.g.*, R. 93–97, 109–116.

[2] The original application had been for the mark "Goodyear by Weatherite," and this was changed in one of the amendments.

215-605—66

upon re-examination, decided that Weather-Rite was entitled to the registration sought, and the Commissioner, in accordance with 15 U.S.C. 1062, thereupon had the proposed mark published in the *Official Gazette*. No opposition was filed within thirty days after publication—the prerequisite, under 15 U.S.C. 1063, to instituting an opposition proceeding. After the period for the filing of oppositions had expired, the Patent Office discovered that the specimen that had been submitted with the application was not one of the goods specified in the amended application, as required by Rule 2.56 of the Patent Office, 37 C.F.R. 2.56, and accordingly ordered the application re-examined. Weather-Rite promptly submitted corrected specimens,[3] and the examiner found the mark to be entitled to registration without need for republication.

Although petitioner had long been aware of the application for registration (*e.g.*, Pet. 6), it waited until the afternoon of November 23, 1964—the day before the trade-mark was to issue—to file an application in the district court for a temporary restraining order (R. 71–74), which it obtained *ex parte* at 4:00 p.m. that day (R. 74–75). Shortly thereafter, petitioner amended the complaint it had filed in the district court with its application for a temporary restraining order to request, for the first time, that the Patent Office republish the trade-mark to permit peti-

[3] Contrary to petitioner's suggestion (Pet. 5), a specimen of each of the goods set forth in the application is not required by the Patent Office rules. Rule 2.21, 37 C.F.R. 2.21.

tioner to file an opposition (R. 75–76). The district court granted summary judgment for the Commissioner (238 F. Supp. 509 (D.D.C.)), and the court of appeals affirmed *per curiam* (355 F. 2d 109 (C.A. D.C.)).

The sole issue here is whether Rule 2.81 of the Patent Office (Pet. App. 16a–17a), 37 C.F.R. 2.81, required that the mark be republished after Weather-Rite submitted the corrected specimens. Rule 2.81 provides:

> If, on examination or re-examination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition.

In compliance with this rule, the mark here was published after re-examination, when the examiner believed that the applicant was entitled to have his mark registered. The subsequent furnishing of new specimens was clearly not a ground upon which petitioner could oppose registration of the mark,[4] and no amendment was made to the application for registration or to the mark itself that could have provided a new ground for opposition. In these circumstances, the Patent Office has consistently, and quite properly, refused to expose an applicant to a second thirty-day

[4] Lack of proper specimens is not a proper ground for opposition. It is a matter easily correctible and in any event one as to which an opponent would have no ground for complaint. That is why such lack is regarded by the Patent Office as a matter that can properly be considered on an *ex parte* basis.

period for opposition. Cf. *Carter Medicine Co.* v. *Barclay*, 36 App. D.C. 123; *Wilson* v. *Delaunay*, 245 F. 2d 877 (C.C.P.A.). No purpose would be served thereby. Rule 2.81 and the underlying statute, 15 U.S.C. 1062, require only that a proposed mark be subjected once to the thirty-day period for opposition. Hence, unless changes are made in the application that would give potential objectors a ground for opposition that did not exist at the time of the first publication, republication is unnecessary to comply with rule and statute. Having failed to oppose within the permitted time period, petitioner is remitted to its remedies of a cancellation proceeding (15 U.S.C. 1064) or a suit for unfair competition and/or trade-mark infringement (15 U.S.C. 1119)—remedies which, as the district court pointed out (Pet. App. 3a), are perfectly adequate, and unaffected by petitioner's failure to oppose within the prescribed time limit.

The decision below is clearly correct and further review is not warranted.[5] The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

THURGOOD MARSHALL,
Solicitor General.

APRIL 1966.

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[5] The conflict between the court of appeals below and the Court of Customs and Patent Appeals alleged by petitioner (Pet. 9) has no relevance to this case, where the only question is the meaning of Rule 2.81, not the presumption of correctness—the issue in the cited cases. As to the alleged admission of inconsistency by the Solicitor of the Patent Office (Pet. 9), we find no basis for the allegation in the record, either at the page cited in the petition or elsewhere.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

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v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITIONER'S REPLY TO RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Respondent seeks to condone the slipshod manner in which the administrative process is regarded by the Executive Branch, the result of which is denial of due process to the public.

Although Respondent admits at page 2 of the Memorandum in Opposition that the specimen on file at the time of the abortive publication of the mark did not satisfy the requirement of the Commissioner's rules

and that a "re-examination" was made,[1] footnote 3 at page 2 of Respondent's Memorandum in Opposition contradicts the action taken. The fact is that there was *no* specimen showing use of the mark on *any* of the goods named in the application at the time of the abortive, premature publication. That is why the application was re-examined and registration was refused *after* publication in the Official Gazette.

Respondent is less than candid in representing to the Court at page 2 of his Memorandum that petitioner "waited until the afternoon of November 23, 1964—the day before the trademark was to issue—to file an application in the District Court for a temporary restraining order". This flagrant disregard or misrepresentation of the facts is reprehensible, particularly coming to the Court in the name of the Solicitor General, himself.

The fact is that the Commissioner of Patents had "mislaid" petitioner's "Request for Reconsideration" (R. 17) to which petitioner was awaiting the Commissioner's reply, the following transactions having occurred between July 16, 1964 and November 23, 1964 (R. 10-70):

July 16, 1964—Petitioner filed "Petition to the Commissioner of Patents" (R. 9-10)

August 5, 1964—Commissioner Denied Petition filed July 16, 1964 (R. 11)

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[1] The respondent erroneously states at pages 1-2 that a "patent examiner" re-examined the trademark application involved herein. (See Section 12(a) Trademark Act of 1946, Appendix C-1, pages 10a-11a of present petition to effect that trademark applications are referred to the examiner in charge of registration of marks.)

October 2, 1964—Petitioner filed "Renewed Petition to the Commissioner of Patents" (R. 12-15)

October 6, 1964—Commissioner Denied "Renewed Petition" (R. 15-16)

October 9, 1964—Petitioner filed "Request for Reconsideration of Decision of Commissioner of Patents and Renewed Petition to Withhold Issuance of Registration" (R. 17-70)

October 12, 1964—Examiner Requested Restoration of Jurisdiction over Application and Commissioner Restored Jurisdiction (R. 146)

October 12, 1964—Application Withdrawn from Issue (R. 221)

October 15, 1964—Examiner Refused Registration (R. 222-223)

October 22, 1964—Applicant filed New Specimens and Affidavit (R. 149-156)

October 22, 1964—Refusal Withdrawn in View of Submission of New Specimens and applicant notified of application being passed to issue and that it would "mature into a registration" in due course of business, no notice thereof to petitioner.

November 23, 1964—Petitioner filed Complaint and Application for Temporary Restraining Order (R. 1-74)

November 23, 1964—Court Issued Temporary Restraining Order (R. 74-75)

November 24, 1964—Examiner and Commissioner Effect Withdrawal of Application from Issue (R. 79-80)

November 25, 1964—Commissioner Denied "Mislaid" Petition for Reconsideration filed by Petitioner on October 9, 1964 (R. 81-82)

November 27, 1964—Petitioner Amended Complaint (R. 75-76)

The delay, if any, in the foregoing chronology was attributable to the Commissioner for having "mislaid" petitioner's "Request for Reconsideration" from October 9, 1964 to November 25, 1964. Thus, it was only *after* petitioner invoked the extraordinary remedy of a temporary restraining order that the Commissioner took any steps to consider petitioner's "Request for Reconsideration". *However, in the meantime, the application was being re-examined, amended and passed to issue without any notice whatever to petitioner as to the action being taken.* It was only upon making inquiry as to the status of the matter that petitioner learned that the application was about to "mature" into a registration, *without publication in the Official Gazette,* "in due course of business".

There is no authority whatever for respondent's assertion in footnote 4, page 3 of his Memorandum in Opposition that "Lack of proper specimens is not a proper ground for opposition". An opposer is likely to be damaged by issuance of a registration contrary to law, regardless of the respect in which the application is legally insufficient since a registration, once it is issued, carries a statutory presumption of validity. The cavalier fashion in which respondent disposes of such points without supporting authority illustrates the reason why the present petition should be granted.

RESPONDENT MISSTATES CITED CASES

The cases cited at pages 3-4 of respondent's "Memorandum in Opposition" are *contrary* to the proposition for which they are cited by respondent and actually support petitioner's position. In each of the cited cases the Commissioner caused the respective marks to be published a second time. In every instance in

which the question of second publication of a mark has arisen, except the present case, *the mark has been published a second time.*

On the other hand, respondent erroneously represents to this Court, at the bottom of page 3 of his Memorandum that "the Patent Office has consistently, and quite properly, *refused* to expose an applicant to a second thirty-day period for opposition" (emphasis added by petitioner). In support of this statement, respondent cites two cases, in each of which the Commissioner *published the mark a second time* and exposed the applicant to a second period for opposition.

Since the right of the Commissioner to publish a mark a second time has been upheld both by the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit we now have an anomalous situation where the Commissioner, in the face of the precedents, *refuses* to publish a mark a second time. This type of conflict, particularly since it involves an abuse of the administrative process, cries out for rectification by this Court.

THE QUESTION OF LAW

Petitioner submits that the point of law involved here must be stated as follows:

> "A trademark registration may not be validly issued without further publication if, at the time of initial publication in the Official Gazette for opposition as provided in Sections 12(a) and 13 of the Trademark Act of 1946, the application was not in compliance with all statutes and rules relating to registration of marks."

Respondent's version would allow for publication of a mark when the application is not in compliance with

the statutes or rules and then would permit unlimited amendments thereto after the period for opposition had expired, thereby precluding the public from ever opposing the issuance of an invalid registration. It is the right of the public to oppose under Section 13 of the Trademark Act of 1946 which is involved here—not recourse to other statutes or other remedies at other times.

SUMMARY DISPOSITION

In view of the undisputed facts in the present case, petitioner respectfully submits that the present matter may be disposed of summarily by the Court granting the present petition, reversing the judgment of the Court of Appeals for the District of Columbia Circuit and directing the Court to require the Commissioner of Patents to publish the mark in its present condition in accordance with Section 12(a) of the Trademark Act of 1946.

If the Court does not consider the matter ripe for determination in a summary way, petitioner prays that, at least, the petition be granted and the case be set for briefing and oral argument on the merits.

Respectfully,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

Petitioner respectfully prays that this Court grant rehearing of its order of May 16, 1966 denying its petition for writ of certiorari and that a writ of certiorari issue to review the judgment of the Court of Appeals for the District of Columbia Circuit in the present case as prayed for in the petition filed herein March 28, 1966.

It is realized that, based on published statistics, the "odds" in favor of the Court granting the present petition are less than one out of a hundred. However, since we are dealing here with a serious, important matter of law, not a game of chance, petitioner wishes to impress upon the Court, by the present petition, the dire necessity for granting a review of this case on its merits; otherwise justice will be irrevocably denied.

I. REASONS FOR GRANTING REHEARING AND ISSUING WRIT OF CERTIORARI

A. Litigation Against Commissioner of Patents Under Administrative Procedure Act, Being Concentrated in District of Columbia Circuit, Renders Conflict as Basis for Granting Writ of Certiorari Improbable, Except for Conflict Within Circuit

The Supreme Court in *Schriber-Schroth Co.* v. *Cleveland Trust Co. et al.*, 305 U.S. 47; 59 S. Ct. 8 (1938), (a 100-to-one "long shot" which paid off), granted a petition for rehearing of an order denying a petition for writ of certiorari on the ground that the concentration of litigation in a single circuit (the Sixth) on the subject of the petition made it "improbable" that an opportunity for conflict with another circuit would ever arise.

In the present case, it is improbable that a conflict will ever arise in another circuit with respect to an action against the Commissioner of Patents under the Administrative Procedure Act. The Court of Customs and Patent Appeals has no authority to judicially review such actions, and so far the only circuit court in which such actions have arisen, due to the fact that the Commissioner is a resident of the District of Columbia, is the Court of Appeals for the District of Columbia Circuit.

There is, in fact, a conflict *within* the District of Columbia Circuit with respect to the specific question presented here.[1] The conflict lies in the fact that more than 50 years ago the Court of Appeals for this circuit

[1] The Solicitor General's Memorandum in Opposition, footnote 5, page 4, agrees that the ultimate question here is whether or not publication of a mark must take place a second time under Rule 2.81 in the light of the circumstances of the given case.

in *Carter Medicine Co.* v. *Barclay,* 36 App. D.C. 123 (1910) ruled that the Commissioner acted properly in publishing a mark a second time, holding that an applicant *should* be subjected to the hazards of publication of a mark a second time if it is "possible for an opposition to lie against the amended application, and not against the original". In the present case the Commissioner refuses to publish the mark a second time, the Court holding now that a second publication should *not* take place even though it is "possible for an opposition to lie against the amended application and not against the original". To paraphrase the statement of Mr. Justice Stewart in his dissenting opinion in the recent case of *United States* v. *Von's Grocery Company, et al.,* 34 Law Week 4425 (U.S. May 31, 1966), and to apply it to the situation presented here, "The sole consistency that I can find is that in litigation [against the Commissioner of Patents] the government always wins."

B. Other Grounds for Opposition Which Now Exist But Which Did Not Exist When Mark Was First Published

1. New Specimens Filed After First Publication

Since new specimens were filed *after* the first publication, it is abundantly clear that "a ground for opposition to the mark" was raised by this change in the application which was not present in the original application. The matter is prejudged if petitioner is not afforded an opportunity at least to show that it is "possible for an opposition to lie against the amended application", which possibility did not exist when the mark was first published. There were *no* specimens in the record at the time of first publication from which it could be determined whether or not the mark was

ever used on the goods named in the application, or if ever used, whether such use was in "foreign" rather than "interstate" commerce and whether or not the specimens showed use of the mark on goods of which the mark was merely descriptive, deceptive, deceptively misdescriptive, or generic.[2]

In other words, the Court of Appeals for the District of Columbia Circuit held, on the one hand, in *Carter Medicine Co.* v. *Barclay, supra,* that there *should* be a second publication if a *possibility* of opposition exists after amendment which did not exist before amendment; but in the present case, even though a *possibility* of opposition arose after amendment (by addition of specimens) which did not exist before amendment (because there were *no* specimens showing use of the mark on the goods named in the application), the Court *refuses* to order a second publication. It is impossible for the Patent Office or the Court to be sufficiently omniscient to foresee and prejudge all of the *possibilities* of opposition which might arise from the inclusion of new specimens in an application after the mark was first published, particularly where the application was formerly rejected by the Examiner for lack of specimens. Petitioner is entitled to his "day in Court" to be heard on the sufficiency of such

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[2] The Solicitor General (Memorandum in Opposition, footnote 4, page 3) takes the position that "Lack of proper specimens is not a proper ground for opposition. It is a matter easily correctable and, in any event, one as to which an opponent would have no ground for complaint. That is why such lack is regarded by the Patent Office as a matter that can properly be considered on an *ex parte* basis."

The Court of Customs and Patent Appeals, however, in *Cardinal Engineering Co.* v. *Champion Mfg. Co.,* 300 F. 2d 957; 133 USPQ 197 (1962) takes a contrary position as to the right of a party to be heard on a so-called *ex parte* issue.

specimens to show lawful use in commerce which may lawfully be regulated by Congress.

2. Court Adjudication Since First Publication

The United States District Court for the District of Minnesota (Third Division) in an opinion dated May 12, 1965 in No. 3-64-Civ. 357 enjoined H. Rosenthal Co. from selling or importing goods bearing the mark in question. *The Goodyear Tire & Rubber Company* v. *H. Rosenthal Co.,* 246 F. Supp. 724, 729; 147 USPQ 92, 95 (D. Minn. 1966). This adjudication took cognizance of, but distinguished the case from, the 78 year old decision of the Supreme Court in *Goodyear's India Rubber Glove Mfg. Co.* v. *Goodyear Rubber Co.,* 128 U.S. 598; 9 S. Ct. 166 (1888).

In view of the existence of a judicial determination that use of "GOODYEAR DELUXE BY WEATHERITE" is unlawful, petitioner now has a ground of opposition which did not exist when that mark was first published.

3. Facts Made of Record After First Publication Show Use on Imported Goods and Investigation by Other Government Agencies as to Lawfulness of Use of Mark in Foreign Commerce

The goods involved in the application are imported from Japan, a fact to which the applicant scrupulously avoided making reference in its representations to the Patent Office. In fact, the application (R. 88) designates only use in "interstate" commerce as the basis for the registration sought. Since the goods are imported from Japan, the first use must have been in "foreign" commerce. Even after it was brought to the

attention of the Commissioner of Patents that applicant was falsely representing that the mark was already registered (R. 17-19) and that the Bureau of Customs, the Federal Trade Commission and even the Department of Commerce itself were investigating the lawfulness of the use of the mark by the applicant (R. 13, 20, 77, 143), the Patent Office accepted the new specimens and ignored the question of lawfulness of use of the mark in foreign commerce between Japan and the United States. In view of the fact that such use has since been judicially determined to be unlawful, the new specimens afford a possible ground for opposition which did not exist at the time of first publication.

4. Possibility That Mark Has Been Abandoned Since First Publication

The record also contains evidence which raises a question as to whether or not the use of GOODYEAR was *abandoned* by applicant *after* the first publication, thereby giving petitioner a ground for opposition which did not exist at the time of first publication. A letter dated October 7, 1964 on the applicant's letterhead, signed by the same officer of the company who signed the affidavit which accompanied the new specimens (R. 69) clearly states that "GOODYEAR markings" would be removed from all shipments to the addressee.

This, coupled with the fact that 14 days later the affiant swore only that the newly submitted specimen *was* in use when the application was originally filed, but does not assert that the mark was *still* in use when he signed the affidavit, leaves open the question as to whether use of GOODYEAR was abandoned by the applicant shortly *before* the time the new specimen was submitted.

5. New "Possible" Grounds of Opposition Meet Criteria for Second Publication of Mark

Each of the *four* points mentioned above constitutes a "possible" ground for opposition which did not lie against the application at the time of first publication but which did lie against the application *after* amendment. Thus the decision of the Court of Appeals for the District of Columbia Circuit in the present case is in *direct conflict* with its own precedent in *Carter Medicine Co.* v. *Barclay, supra.* Unless this is another situation in which "the government always wins", certiorari should be granted and petitioner should at least be given an *opportunity* to win. The government should not be permitted to "eat its cake and have it too" in the District of Columbia Circuit merely by twisting the controlling precedent in this circuit as if it were a "nose of wax" to accommodate the whims of the Commissioner of Patents from one situation to another.

C. Review of Grounds of 1888 Decision of Supreme Court Long Overdue

1. 1888 Decision Being Misused, Misinterpreted and Misrepresented by Applicant

At every turn Weather-Rite has urged, albeit erroneously, that the Supreme Court held in 1888 that "GOODYEAR" is free for everyone to use *today* (R. 99, 119). Even the Solicitor General succumbed to the temptation to try to ride the dead horse (Memorandum in Opposition, footnote 1, page 1). The fact of the matter is that use of "GOODYEAR" as a *trademark* was not involved in the 1888 decision except as *obiter dictum.* The Court actually said:

> "The designation Goodyear Rubber Company not being subject to exclusive appropriation, any

> use of terms of similar import, or any abbreviation of them, must be alike free to all persons." 128 U.S. at 604; 9 S. Ct. at 168.

The District Court in Minnesota (supra, 246 F. Supp. 724, 728; 147 USPQ 92, 94), at least, showed that it was not going to fall for an infringer's interpretation by pointing out that the Supreme Court decision in 1888, while involving company names, did not involve either "secondary meaning" or "passing off"[3] the goods of one party for those of another. Indeed the doctrine of "secondary meaning" did not really evolve until the turn of the century. The trend toward recognition of the right of one party to exclusive use of a trademark which was once a geographical term, a descriptive term, or even a surname, is illustrated by the opinion of Chief Justice Fuller rendered more than a decade after 1888 in *Elgin National Watch Company* v. *Illinois Watch Case Company,* 179 U.S. 665; 21 S. Ct. 270 (1901). In that case Chief Justice Fuller said:

> "It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public, and on those to whose employment of it the special meaning has become attached.
>
> In other words, the manufacturer of particular goods is entitled to the reputation they have acquired, and the public is entitled to the means of distinguishing between those and other goods; and

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[3] Mr. Justice Field, in the 1888 opinion, said:

"There is no proof of any attempt of the defendant to represent the goods manufactured and sold by him as those manufactured and sold by the plaintiff;" 128 U.S. at 604; 9 S. Ct. at 168.

protection is accorded against unfair dealing, whether there be a technical trademark or not. The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another." 179 U.S. at 674; 21 S. Ct. at 274.

The doctrine of "secondary meaning" was first accorded statutory recognition in the Trademark Act of 1905. The "ten year proviso" of that Act permitted registration of "any mark used by the applicant or his predecessor * * * which was in actual and exclusive use as a trademark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five". The doctrine is carried forward and further liberalized in the Trademark Act of 1946, Section 2(f), wherein the Commissioner is permitted to register any mark "which has become distinctive of applicant's goods in commerce". He is permitted to accept proof of *substantially*[4] exclusive and continuous use as a mark by the applicant in commerce for the five years next preceding the date of filing the application for registration as prima facie evidence that the mark has become distinctive of the applicant's goods in commerce.

The time is ripe for the Supreme Court to update the trademark case law and bring it into harmony with the statute. The Bulova case, *Steele* v. *Bulova Watch Co.*, 344 U.S. 280; 73 S. Ct. 252 (1952) did not reach any substantive trademark question but dealt only with the matter of jurisdiction and venue. Neither

[4] The legislative history of the Lanham Act (Trademark Act of 1946) shows that the word "substantially" was deliberately intended to relax the standard of absolute exclusiveness of use required under the "ten year proviso" of the 1905 Act so as to disregard infringing uses or insignificant use by others in determining "secondary meaning".

did the Dairy Queen case, *Dairy Queen, Inc.* v. *Wood,* 369 U.S. 469; 82 S. Ct. 894 (1962) get down to the real meat of the trademark issue since it only went into the contract issue.

If the present petition for writ of certiorari is not granted, it will mean that the Commissioner of Patents will be depriving petitioner of its lawful right to oppose the application of Weather-Rite for registration of "GOODYEAR DELUXE BY WEATHER-ITE" and thus deprive the Supreme Court forever of the opportunity to pass on the correctness of the inconsistent actions of the Commissioner of Patents and the Courts of the District of Columbia Circuit with respect to the criteria for publication of a mark a second time. Upon publication a second time, an opposition can be filed by petitioner or others who may have a ground for opposition now but did not have sufficient grounds on the basis of the mark as first published and the Patent Office and the Courts can reach the merits of the question as to whether or not Weather-Rite is entitled to receive a registration which includes a mark as to which petitioner has established a "secondary meaning" as a trademark and trade name on its own behalf over the years long since 1888.

2. Consideration of Cases Involving Surname Trademark Rights Long Overdue

Several petitions for writs of certiorari have been filed in the Supreme Court in an effort to have it review and settle the case law regarding exclusive rights in surnames as trademarks. See for example *S. C. Johnson & Son, Inc.* v. *Johnson Products Co.,* cert. den. 338 U.S. 860; 70 S. Ct. 103 (1949); *S. C. Johnson & Son, Inc.* v. *Phil J. Johnson et al.,* cert den. 361 U.S.

820; 80 S. Ct. 65 (1959); and *Staley Milling Co.* v. *A. E. Staley Mfg. Co.*, cert. den. 357 U.S. 928; 78 S. Ct. 1371 (1958).

The antiquated cases of *Singer Mfg Co.* v. *June Mfg. Co.*, 163 U.S. 169; 16 S. Ct. 1002 (1896); *Howe Scale Co.* v. *Wykoff, Seamans & Benedict*, 198 U.S. 118; 25 S. Ct. 609 (1905); *Thaddeus Davids Company* v. *Davids*, 233 U.S. 461; 34 S. Ct. 648 (1914); and *L. E. Waterman Company* v. *Modern Pen Company*, 235 U.S. 88; 35 S. Ct. 91 (1914) have, most surely, been superseded by later development of the trademark law relating to exclusivity in surname trademarks, but yet are urged upon the lower Courts every time a surname case arises, since they have neither been overruled, distinguished, nor clarified by the Supreme Court.

The Patent Office itself would benefit greatly by a current review of the 1888 decision of the Supreme Court in *Goodyear's India Rubber Glove Mfg. Co.* v. *Goodyear Rubber Company, supra.* In Opposition 44,248, *The Goodyear Tire & Rubber Company* v. *Irving Raincoat Co.*,[5] the Trademark Trial and Appeal Board, on January 14, 1965, commented on the 1888 decision of the Supreme Court in this way:

> "Applicant moves for summary judgment under the provisions of Rule 56 FRCP on the ground that there is no triable issue of fact as to whether

[5] In that proceeding, registration of "GOODYEAR DELUXE BY IRCO" is being sought. The specimens corresponding to the goods named in the application were on file at the time of publication, and there was no re-examination of the application after publication, as was true in the case at bar. The specimens in that application showed on their face that the goods were imported from Japan and the lawfulness of use of the mark and the applicant's claim of ownership thereof were challenged by the Examiner and are in issue in the pending opposition.

opposer has any rights in the term 'GOODYEAR' since the Supreme Court in *Goodyear Glove Manufacturing Company* v. *Goodyear Rubber Company,* decided in 1888, held that the name 'GOODYEAR RUBBER COMPANY' or any abbreviation thereof is not capable of exclusive appropriation. A brief in opposition to the motion has been filed by opposer.[1]

* * * *

"In the absence of any evidence of privity, opposer is not estopped by the above cited decision from maintaining this proceeding; hence, the issue turns on whether the decision in question represents the law in this case.

"In this regard we are not satisfied that the showing made by applicant in support of the motion excludes any real doubt as to the existence of any genuine issue of material fact considering the substantial changes in the law and the absence of any facts of sufficient probative force to establish that the reasons upon which the Supreme Court decision was grounded more than seventy-five years ago are equally applicable today. Even

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[1] Applicant has filed a reply brief to opposer's response which opposer seeks to strike. Opposer also requests in the alternative an oral hearing on the various pending motions.

There is no provision in the rules for the filing of a response to a reply brief on a motion; and applicant's brief will not therefore be considered. See: *The Electric Storage Battery Company* v. *Mine Safety Appliances Company,* 140 USPQ 671 (TT&A Bd., 1963). Even if such a brief were to be considered, the mere fact that the designation "GOODYEAR RUBBER COMPANY" or similar appellations have been disclaimed on a number of occasions by a third party in obtaining trademark registrations before this Office under the Act of 1905 is not conclusive upon the question because whatever inferences may be drawn therefrom conflicts with such deductions as may be obtained from the fact that no disclaimer was entered by opposer in Registration No. 57,590 for "GOODYEAR" & design. See: *Paul E. Hawkinson, supra.*

In view of the foregoing, there is no occasion to consider opposer's alternative request.

assuming arguendo that the term "GOODYEAR" is not capable of exclusive appropriation, the case is still not in condition for summary judgment inasmuch as this would not dispose of the question of likelihood of confusion as between applicant's mark which includes the phrase "GOODYEAR DELUXE BY" and opposer's mark "GOODYEAR DELUXE" as applied to the specified goods. It is concluded, therefore, that the summary judgment procedure is inapplicable."

II. CONCLUSION

Admittedly, an overwhelming burden rests on petitioner to establish, on a petition for rehearing, why the Court should take the present case, having once denied certiorari. Petitioner has tried, therefore, to avoid repetition of grounds urged in the original petition and to lay emphasis on new grounds, at least some of which may appeal to the Court as being meritorious. The entire thrust of the present petition is to appeal to the sensibilities of the Court in a calm, dispassionate manner. As a consequence, petitioner hopes that the impact of this petition will be such as to convince the Court that the relatively short time which would be required to dispose of the case on its merits will induce the Court to find a few minutes on its heavy calendar to hear us out.

There is precedent for granting a petition for rehearing where the litigation to which the question pertains is concentrated in one circuit and the likelihood of a conflict arising in another circuit is remote. *Schriber-Schroth Co.* v. *Cleveland Trust Co., supra.*

There is also precedent for reviewing, in the light of changed circumstances, decisions of the Supreme Court which were rendered more than three-quarters of a century ago against a background which no longer

exists or which has so changed as to warrant a different result. *Brown* v. *Board of Education,* 347 U.S. 483, 492-3; 74 S. Ct. 686, 691 (1954) and related cases.

There is also precedent for re-examining the case law where a reasonable length of time has lapsed since the enactment of a new statute or so-called codification of the case and statutory law.[6] *Graham* v. *John Deere Co.,* 379 U.S. 956; 86 S. Ct. 684 (1966).

Where there is no precedent, the Supreme Court is in a position to set the precedent by granting certiorari and taking the case on its merits, particularly where, as here, the fact situation is simple but the underlying principles and their effect on the public are substantial. The administrative process, affecting the life of every citizen, as it does, requires application of that ultimate judicial review and scrupulous analysis which only the Supreme Court can provide.

In conclusion, petitioner prays that the present petition for rehearing be granted and that the writ of certiorari sought in the original petition and the present petition be granted.

Respectfully,

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[6] The Trademark Act of 1946 has been in force now for nearly 20 years, during which time the Supreme Court has not considered Section 2(f) of the Act in the light of the change from the "ten year proviso" of the 1905 Act or the common law cases involving exclusive right to use of a surname, a descriptive term or a geographical term as a trademark.

CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

.....

Counsel for Petitioner.